

### **REMARKS**

By this Amendment After Final, Applicant has proposed adding new independent claim 39, which is equivalent to previously-pending claim 26, rewritten in independent form. Thus, no new matter would be added by entry of new claim 39, and further, no new issues that have not been previously considered by the Examiner would be added by entry of new claim 39.

Upon entry of new claim 39, claims 1-4 and 6-39 would be pending on the merits. For at least the reasons outlined herein, Applicant respectfully requests reconsideration and withdrawal of the claim objection and rejections, entry of new claim 39, and allowance of pending claims 1-4 and 6-39.

#### **I. Claim Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 1, 29, and 36-38 were rejected under 35 U.S.C. § 112, second paragraph, based on an assertion that those claims are indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the inventions. Final Office Action at 2. In particular, the rejection statement asserts that “[i]t is unclear whether Applicants claim a particle size distribution wherein at least 40% by weight of the calcined kaolin has a particle size of at least about 1  $\mu\text{m}$  or wherein at least 40% by weight of the calcined kaolin has a particle size of at least 2  $\mu\text{m}$ .” Id.

Applicant respectfully submits that claims 1, 29, and 36-38 comply with 35 U.S.C. § 112, second paragraph, in the present form. Based on the rejection statement’s purported rationale in support of the claim rejection, it appears that Applicant’s claims

have been misinterpreted, such that the recited “at least about 40% by weight having a particle size of at least about 1  $\mu\text{m}$ ” and the recited “at least about 40% by weight having a particle size of at least about 2  $\mu\text{m}$ ” relate to mutually exclusive groups of particles. This is not necessarily the case. At least some of the group of particles that are at least about 1  $\mu\text{m}$  may be present in the group of particles that are at least about 2  $\mu\text{m}$ . On the other hand, some of the group of particles that are at least about 1  $\mu\text{m}$  may fall within a range of between about 1  $\mu\text{m}$  and about 2  $\mu\text{m}$ . But regardless of what percentage of the total particles range from about 1  $\mu\text{m}$  to about 2  $\mu\text{m}$ , at least about 40% of the total particles are at least about 2  $\mu\text{m}$ . Thus, Applicant respectfully submits that contrary to the rejection statement’s indefiniteness assertion, independent claims 1, 29, 36, 37, and 38 are clear in scope and meaning.

Moreover, Applicant further submits that according to the M.P.E.P., “[b]readth of a claim is not to be equated with indefiniteness . . . .” § 2173.04. Indeed, the M.P.E.P. advises that “[i]f the scope of the subject matter embraced by the claims is clear, and if Applicants have not otherwise indicated that they intend the invention to be a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.” Id.

Applicant respectfully submits that the scope of the subject matter recited in each of independent claim 1, 29, and 36-38 is clear. For at least those reasons, Applicant respectfully submits that claims 1, 29, and 36-38 fully comply with 35 U.S.C. § 112, second paragraph, and respectfully request reconsideration and withdrawal of the claim rejection under § 112, second paragraph.

**II. Claim Objection under 37 C.F.R. § 1.75(c)**

Claim 2 was objected to under 37 C.F.R. § 1.75(c), based on an assertion that claim 2 is of improper dependent form for failing to further limit the subject matter of the previous claim. Final Office Action at 2. Applicants respectfully submit that claim 2 further limits the scope of claim 1 by reciting an upper bound not recited in claim 1.

According to the M.P.E.P., “[t]he test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends . . .[,] or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” § 608.01(n)(III).

Applicant respectfully submits that it would not be possible to infringe dependent claim 2 without also infringing independent claim 1, the claim from which dependent claim 2 depends. In particular, dependent claim 2 further limits the scope of independent claim 1 by reciting, “wherein at least about 40% by weight of the calcined kaolin has a particle size ranging from about 1  $\mu\text{m}$  to about 10  $\mu\text{m}$ .” Independent claim 1 recites, among other things, “wherein at least about 40 % by weight of the calcined kaolin has a particle size of at least about 1  $\mu\text{m}$  . . . .” By virtue of the open-ended nature of this recitation in independent claim 1, particles having a size greater than 1  $\mu\text{m}$  could also have a size greater than about 10  $\mu\text{m}$ . Similarly, according to claim 1, particles having a size greater than about 2  $\mu\text{m}$  could also have a size greater than about 10  $\mu\text{m}$ . Thus, by reciting in claim 2 that at least about 40% of the particles range from about 1  $\mu\text{m}$  to about 10  $\mu\text{m}$ , claim 2 limits the scope of the subject matter

recited in independent claim 1. Further, Applicant respectfully submits that it would not be possible to infringe dependent claim 2 without also infringing independent claim 1.

For at least the above-outlined reasons, Applicant respectfully submits that claim 2 is in proper dependent form with respect to independent claim 1 from which it depends. Therefore, it is in compliance with 37 C.F.R. § 1.75(c), and thus Applicant respectfully requests reconsideration and withdrawal of the objection to claim 2.

### **III. Claim Rejections under 35 U.S.C. § 103(a)**

In the final Office Action, claims 1-4, 6, 13-15, 26, 27, 29, 30, 34, 35, and 37 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 3,754,712 to Cecil (Cecil). Final Office Action at 3. In addition, claims 23-25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 5,781,756 to Mohler (Mohler). Id. at 5. Claim 28 was rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 3,309,214 to Joseph et al. (Joseph). Id. at 6. Claims 7-12, 19-22, 31, 32, 37, and 38 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Pat. App. Pub. No. 2003/0177952 to Cummings et al. (Cummings), U.S. Patent No. 4,716,186 to Portnoy et al. (Portnoy), and U.S. Patent No. 3,801,332 to Cadmus (Cadmus). Id. at 6. Applicant respectfully submits that the rejected claims are patentably distinguishable from the references relied on in the claim rejections, and requests reconsideration and withdrawal of the claim rejections for at least the reasons outlined below.

**A. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil**

Claims 1-4, 6, 13-18, 26, 27, 29, 30, 34, 35, and 37 were under § 103(a) based on Cecil. Claims 1, 29, and 37 are the only independent claims included in that claim rejection, and Applicant respectfully submits that those claims are patentably distinguishable from Cecil.

The rejection statement asserts that Cecil discloses “an aqueous suspension or slurry of calcined kaolin clay having 70 percent solids suspension wherein [the] slurry contains at least 35 percent by weight of particles coarser than 2 microns . . . .” Final Office Action at 3. The rejection statement further asserts that “there is overlapping ranges of particle size disclosed in the reference with the one claimed in the instant application.” Id. Thereafter, the rejection statement asserts that “[s]ince overlapping ranges have been held to establish prima facie obviousness, it would have been obvious to have selected from the overlapping portion of the range of particle size and the percentage of that particle size as that taught by Cecil to have reache[d] the invention as claimed.” Id. at 3-4 (citation omitted).

Without agreeing with the assertion that Applicant’s independent claims 1, 29, and 37 and Cecil respectively recite and disclose overlapping ranges related to particle size, Applicant respectfully submits that even if for the sake of argument, overlapping ranges are present, independent claims 1, 29, and 37 are not obvious at least because those claims recite a range that is critical, as evidenced by unexpected results achieved, at least in part, due to the recited range.

According to the M.P.E.P., a prima facie case of obviousness based on overlapping ranges is rebuttable by showing the criticality of the claimed range through, for example, a showing of unexpected results. § 2144.05(III). Thus, even if for the sake of argument, the rejection statement has hypothetically established a prima facie case of obviousness based on an overlapping ranges assertion, such a prima facie case may be overcome by showing that the range recited in the claims is critical.

Applicant respectfully submits that the range recited in Applicant's independent claims 1, 29, and 37 is critical, as evidenced at least by virtue of the high-solids composition, as recited in independent claims 1, 29, and 37, having achieved unexpected results. For example, the high-solids compositions recited in independent claims 1, 29, and 37 unexpectedly retain the gloss, brightness, and/or sheen generally only associated with compositions that included higher volumes of calcined kaolin to attain a similar level of gloss, brightness, and/or sheen. See, e.g., Applicant's Description at pp. 18-19, ¶ [063]. In addition, the recited high-solids compositions exhibit exceptional stability relative to prior compositions, and further may be more desirable because an associated minimized volume of the slurries may allow for ease of handling and/or reduction of transport costs. See, e.g., id. at p. 3, ¶¶ [012], [013]; p. 15, ¶ [061].

For at least the above-outlined reasons, the compositions and methods recited in independent claims 1, 29, and 37 of the present application exhibit unexpected results relative to the cited references based at least in part on the range recited in those claims. For at least this reason, Applicant respectfully submits that independent

claims 1, 29, and 37 are patentably distinguishable from Cecil. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 29, and 37 under 35 U.S.C. § 103(a) based on Cecil.

**B. Claim Rejection under § 103(a) based on Cecil and Mohler**

Claims 23-25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with Mohler. Claims 23-25 and 33 depend respectively from independent claims 1 and 29. For at least this reason, claims 23-25 and 33 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to the claim rejection under § 103(a) based on Cecil alone. Moreover, Mohler fails to overcome the above-outlined deficiencies of Cecil. For at least those reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 23-25 and 33 under 35 U.S.C. § 103(a) based on Cecil in combination with Mohler.

**C. Claim Rejection under § 103(a) based on Cecil and Joseph**

Concerning the rejection of claim 28 under 35 U.S.C. § 103(a) based on Cecil in combination with Joseph, claim 28 depends from independent claim 1. Thus, claim 28 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to the claim rejection under § 103(a) based on Cecil alone. Moreover, Joseph fails to overcome the above-outlined deficiencies of Cecil. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection

of dependent claim 28 under 35 U.S.C. § 103(a) based on Cecil in combination with Joseph.

**D. Claim Rejection based on Cecil, Cummings, Portnoy, and Cadmus**

Concerning the rejection of claims 7-12, 19-22, 31, 32, 37, and 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Cummings, Portnoy, and Cadmus, claims 7-12, 19-22, 31, and 32 depend from a corresponding one of independent claims 1 and 29. For at least this reason, those dependent claims should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to the claim rejection under § 103(a) based on Cecil alone. Moreover, Cummings, Portnoy, and Cadmus, regardless of whether they are viewed individually or as a whole, fail to overcome the above-outlined deficiencies of Cecil. Concerning claims 37 and 38, those claims are independent claims, which also recite, in pertinent part, “at least about 40% by weight of the calcined kaolin has a particle size of at least about 2  $\mu\text{m}$  . . . .” Thus, independent claims 37 and 38 should be patentably distinguishable from Cecil for reasons at least similar to those outlined above with respect to the claim rejection under § 103(a) based on Cecil alone. Moreover, Cummings, Portnoy, and Cadmus, regardless of whether they are viewed individually or as a whole, fail to overcome the above-outlined deficiencies of Cecil. For at least those reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 7-12, 19-22, 31, 32, 37, and 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Cummings, Portnoy, and Cadmus.



In addition, Applicant respectfully traverses the claim rejection under § 103(a) based on Cecil in combination with Cummings, Portnoy, and Cadmus, at least because Cummings does not qualify as prior art with respect to the present application under 35 U.S.C. § 103(a) as set forth in 35 U.S.C. § 103(c). According to 35 U.S.C. § 103(c)(1),

[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Thus, if a reference qualifies as prior art only under §§ 102(e), 102(f), and/or 102(g), and the subject matter disclosed in the reference and the subject matter claimed were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, the reference does not qualify as prior art under § 103(a) with respect to the claims of the application.

Applicant respectfully submits that Cummings does not qualify as prior art against the claims of the present application because (1) Cummings qualifies hypothetically as prior art, if at all, only under §§ 102(e), 102(f), and/or 102(g); and (2) at the time the invention disclosed in the present application was made, Cummings and the subject matter claimed in the present application were owned by the same entity or subject to an obligation of assignment to the same entity, as will be explained in more detail below.

First, Cummings fails to qualify as prior art under 35 U.S.C. § 102(a) or (b). The present application claims priority to a provisional application filing date of December 2, 2002. Since the publication date of Cummings (September 25, 2003) is not prior to the present application's priority date, Cummings is not prior art under 35 U.S.C. § 102(a) or (b). See 35 U.S.C. §§ 102(a) and 102(b). Further, Cummings does not qualify as prior art under §§ 102(c) or 102(d), since no evidence has been presented that Applicant for the present application either "abandoned the invention" (see § 102(c)), or received a foreign patent or inventor's certificate for "the invention . . . more than twelve months before the filing" of the present application (see § 102(d)). Therefore, Cummings may only qualify as prior art with respect to the present application, if at all, under §§ 102(e), 102(f), and/or 102(g).

Furthermore, Applicant respectfully submits that at the time the present invention disclosed in the present application was made, as described via exemplary embodiments disclosed in the application, the subject matter of Cummings and the present application's claims were subject to an obligation of assignment to Imerys Pigments, Inc. This obligation is evidenced by an Assignment of Cummings to Imerys Pigments, Inc., which was recorded in the U.S. Patent and Trademark Office (USPTO) on July 18, 2002, at Reel 013098, Frame 0573, and an Assignment of the present application to Imerys Pigments, Inc., which was recorded in the USPTO on September 1, 2005, at Reel 016716, Frame 0926.

For at least the above-outlined reasons, Cummings does not qualify as prior art under 35 U.S.C. § 103(a) pursuant to the exclusionary provision of 35 U.S.C. § 103(c).

For at least this additional reason, Applicant respectfully requests withdrawal of the claim rejection under 35 U.S.C. § 103(a) based on Cecil in combination with Cummings, Portnoy, and Cadmus. (Despite the fact that Cummings does not qualify as prior art under 35 U.S.C. § 103(a) for at least the above-outlined reasons, Applicant reserves the right to supplement the traversal of the § 103(a) claim rejection based in part on Cummings with additional remarks in the future if appropriate.)

#### **IV. New Independent Claim 39**

By this Amendment After Final, Applicant has added new independent claim 39, which is directed to, *inter alia*, a calcined kaolin clay that has not been subjected to mechanical grinding. Applicant respectfully submits that new independent claim 39 is patentably distinguishable from Cecil and the other references of record at least because they fail to disclose or render obvious at least this subject matter recited in new independent claim 39. For example, in contrast to the recited subject matter, Cecil discloses kaolin clay that has undergone grinding/ball milling. See, e.g., Cecil at col. 6, ll. 29-33 (claiming a method requiring “wet milling said suspension in the presence of grinding media having a specific gravity above 3 until the viscosity of the clay is reduced sufficiently to permit the addition of more clay without stopping the mill”); Cecil at col. 6, ll. 48-52 (claiming a method requiring “ball milling the resulting slurry with ceramic milling media having a specific gravity above 3 until the viscosity of the suspension is reduced, adding increments of calcined clay, each increment being followed by further ball milling”).

Moreover, as mentioned previously herein, new independent claim 39 is equivalent to previously-pending claim 26, rewritten in independent form. In the final Office Action, claim 26 was rejected under 35 U.S.C. § 103(a) based on Cecil. To the extent that this rejection would be considered applicable to new independent claim 39, Applicant respectfully traverses such rejection.

In the rejection statement apparently relating to claim 26, the final Office Action asserts, “Cecil . . . discloses the possibility of adding the slurry into a mill (for example, ball mill) to grind it (column 3, lines 63-66; column 4, lines 30-34).” Final Office Action at 4. Applicant respectfully notes that the subject matter referenced by the rejection statement does not result in disclosing a calcined kaolin, “wherein the calcined kaolin has not been subjected to mechanical grinding,” as recited in dependent claim 26 and new independent claim 39. Indeed, the rejection statement has failed to identify any disclosure in Cecil that purportedly supports the final Office Action’s rejection of claim 26 under § 103(a) based on Cecil. For at least this reason, Applicant respectfully traverses the rejection of claim 26, and further, respectfully submits that both dependent claim 26 and new independent claim 39 are patentably distinguishable from Cecil.

For at least the above-outlined reasons, Applicant respectfully submits that Cecil fails to disclose or render obvious all of the subject matter recited in new independent claim 39. Thus, new independent claim 39 is patentably distinguishable from Cecil, and Applicant respectfully requests entry and allowance of new independent claim 39.

## **V. Conclusion**

For at least the above-outlined reasons, Applicant's independent claims 1, 29, and 36-39 should be allowable. Dependent claims 2-4 and 6-28 depend from allowable independent claim 1. Consequently, those dependent claims should be allowable for at least the same reasons independent claim 1 is allowable. Dependent claims 30-35 depend from allowable independent claim 29. Similarly, those dependent claims should be allowable for at least the same reasons independent claim 29 is allowable. Thus, all pending claims are allowable.

Concerning the proposed addition of new independent claim 39, new claim 39 is equivalent to previously-pending claim 26, rewritten in independent form. Thus, no new issues that have not been previously considered by the Examiner would be added by entry and consideration of new claim 39. Therefore, Applicant respectfully requests entry and consideration of new independent claim 39.

For the above-outlined reasons, Applicant respectfully requests reconsideration of this application, entry of new independent claim 39, withdrawal of the claim objection and rejections, and allowance of all of pending claims 1-4 and 6-39.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Applicant respectfully submits that the final Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those

assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Request, and charge any additional fees to Deposit Account 06-1916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: 

Christopher T. Kent  
Reg. No. 48,216